



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/942,758 | 08/30/2001 | Maria Azua Himmel | AUS920010408US1 | 9993 |
| 35525 | 7590 | 08/23/2004 | EXAMINER | |
| IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380 | | | BARNIE, REXFORD N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2643 | |

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,758

Applicant(s)

HIMMEL ET AL.

Examiner

REXFORD N BARNIE

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

R N Barnie
REXFORD BARNIE
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1- 9, 11, 13, 14-22, 24 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Katz et al. (US Pat# 6,424,706).

Regarding claims 1 and 14, Katz teaches a method and system for transferring telecommunications time units among accounts and exchanging goods or services where a first subscriber can transfer prepaid time or amount from his/her account to a second subscriber or non subscriber account for that matter for telephony usage in (see col. 2 lines 54-63, fig. 1B (PRIOR ART), col. 7, fig. 4A) via choosing a transfer minutes option of a main menu system.

Regarding claims 2 and 15, see option (412, 414, 416) of fig. 4.

Regarding claims 3-4, 16 and 17, there would be a plurality of accounts and one uniquely identified for transfer of minutes in (see col. 7 lines 1-7).

Regarding claims 5 and 18, the teaching of Katz is applicable to any phone including landline phones or mobile phones.

Regarding claims 6-9 and 19-22, the prepaid minutes can be applied to any toll calls.

Regarding claims 11 and 24, Katz teaches sending a notification signal in (see col. 8 line 48-58).

Regarding claims 13 and 26, the service providers of the sending and receiving parties could be the same or different as long as there is agreement between the various network elements.

Claims 1, 12, 14 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Alperovich (US Pat# 6,175,741).

Regarding claims 1 and 14, Alperovich teaches receiving information identifying a party (recipient), inherent, receiving an indication of a feature to be transferred from one account to the other and transferring the information as such in (see col. 8 lines 39-67).

Regarding claims 12 and 23, transferable feature data could include call forwarding since it can be part of the business card information application

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10, 12, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (US Pat# 6,424,706) in view of Alperovich (US Pat# 6,175,741).

Regarding claims 10 and 23, Katz fails to teach being able to update features including call forwarding from a subscriber to the to other.

Alperovich teaches a system wherein a subscriber can update information in a subscriber phone by using a business card application/information, which can include supplementary service information including call forwarding in (see disclosure). The system can be implemented either in a MS or network element.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Alperovich into that of Katz thus making it possible to remotely program telephone devices or services.

Regarding claims 12 and 25, the art of record fails to teach the claimed subject matter but the examiner takes official notice that it's well known to get permission from a user or subscriber before updating a feature or service.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inform a subscriber before updating a feature for security reasons, not tampering services including deletions of features/services and so forth.

Claims 27-35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (US Pat# 6,424,706).

Regarding claim 27, Katz teaches a method and system for transferring telecommunications time units among accounts and exchanging goods or services where a first subscriber can transfer prepaid time or amount from his/her account to a second subscriber or non subscriber account for that matter for telephony usage in (see col. 2 lines 54-63, fig. 1B (PRIOR ART), col. 7, fig. 4A) via choosing a transfer minutes option of a main menu system. The prior art of record fails to teach in detail a computer medium through which the invention can be implemented.

It's well known in the telecommunications art to implement inventive concepts using a computer system including a memory, bus, processor and so forth and the examiner takes official notice to that regard.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teaching of Katz by using any computer medium for efficiency purposes, without delay and saving computer codes for a long duration of time.

Regarding claim 28, see option (412, 414, 416) of fig. 4.

Regarding claims 29, there would be a plurality of accounts and one uniquely identified for transfer of minutes in (see col. 7 lines 1-7).

Regarding claims 30-31, the teaching of Katz is applicable to any phone including landline phones or mobile phones.

Regarding claims 32-35, the prepaid minutes can be applied to any toll calls.

Regarding claim 37, Katz teaches sending a notification signal in (see col. 8 line 48-58).

Regarding claim 39, the service providers of the sending and receiving parties could be the same or different as long as there is agreement between the various network elements.

Claims 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (US Pat# 6,424,706) in view of Alperovich (US Pat# 6,175,741).

Regarding claim 36, Katz fails to teach being able to update features including call forwarding from a subscriber to the to other.

Alperovich teaches a system wherein a subscriber can update information in a subscriber phone by using a business card application/information, which can include supplementary service information including call forwarding in (see disclosure). The system can be implemented either in a MS or network element.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Alperovich into that of Katz thus making it possible to remotely program telephone devices or services.

Regarding claim 38, the art of record fails to teach the claimed subject matter but the examiner takes official notice that it's well known to get permission from a user or subscriber before updating a feature or service.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inform a subscriber before updating a feature for security reasons, not tampering services including deletions of features/services and so forth.

Claims 27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich (US Pat# 6,175,741).

Regarding claim 27, Alperovich teaches receiving information identifying a party (recipient), inherent, receiving an indication of a feature to be transferred from one account to the other and transferring the information as such in (see col. 8 lines 39-67).

The prior art of record fails to teach in detail a computer medium through which the invention can be implemented.

It's well known in the telecommunications art to implement inventive concepts using a computer system including a memory, bus, processor and so forth and the examiner takes official notice to that regard.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teaching of Alperovich by using any computer medium for efficiency purposes, without delay and saving computer codes for a long duration of time.

Regarding claim 36, transferable feature data could include call forwarding since it can be part of the business card information application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **REXFORD N BARNIE** whose telephone number is (703)306-2744. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CURTIS KUNTZ can be reached on (703) 305-4708. The fax phone

Art Unit: 2643

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRIMARY EXAMINER
REXFORD BARNIE
08/19/04


REXFORD BARNIE
PRIMARY EXAMINER